

REMARKS

Claims 40-55 are pending in the above application.

The Office Action dated April 11, 2007, has been received and carefully reviewed. In that Office Action, claims 52 and 54 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claim 52 is rejected under 35 U.S.C. 102(e) as being anticipated by Shaw. Claims 40-47, 49-51 and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Granik, and claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Granik and further in view of Acres. Each of these issues is addressed below, and reconsideration and allowance of claims 40-55 is respectfully requested in view of the following remarks.

REJECTIONS UNDER 35 U.S.C. 112, FIRST PARAGRAPH

Claim 52 is rejected under 35 U.S.C. 112, first paragraph, as not being enabled by the specification because the specification allegedly does not show the display of an ad before running an application using additional data. The below discussion provides an example of how an embodiment of the present invention supports the language of claim 52, but is not in any manner intended to limit the scope of the claims.

An example of an embodiment of the present invention used in connection with a game of growing a virtual pet is described beginning at page 26 of the application. In this example, the game of growing the virtual pet corresponds to the claimed application and data used by the game, such as characteristics of the pet, etc. comprises data to be acted on by the application. Page 28, line 21 through page 29, line 15 describes running the application using data to be acted on by the application and then terminating the application. Pages 30 and 31 describe a process of receiving additional data and additional advertising data while the application is terminated. The specification explains at page 32, lines 6-30, how the storage medium is then reconnected to a game console, an advertisement based on the additional advertising data is displayed, and then a user presses a "check" button to confirm that the advertisement has been viewed. Page 32, line 23 provides that when a user presses a button 603, the control unit reads the additional data and executes the application using this additional data. Therefore, an ad is displayed before running

the application using the additional data. The ad is based on the additional advertising data; the application does not use the additional data to be operated on by the application (which is different from the advertising data) until after the advertisement is displayed.

Claim 54 is rejected under 35 U.S.C. 112, first paragraph, on the grounds that receiving information while an application is terminated is not enabled by the specification. The above discussion also provides support for claim 54. Page 29, line 33 begins a discussion of a user terminating an application, removing a storage medium from the game, and downloading additional data to the storage medium. Details of this procedure continue on page 30 and 31.

Based on the above comments and identified portions of the specification, it is respectfully submitted that the language of all claims is fully enabled, and the withdrawal of the rejections of claims 52 and 54 under 35 U.S.C. 112, first paragraph, is respectfully requested. Moreover, if the examiner continues to believe these claims are not enabled, it is respectfully requested that the examiner contact Mr. Scott Wakeman at the telephone number of the undersigned so that any remaining concerns of the examiner can be addressed.

REQUEST FOR NEW NON-FINAL OFFICE ACTION

Claim 52 is rejected under 35 U.S.C. 102(b) as being anticipated by Shaw. The rejection of claim 52 is substantially identical to the rejection of claim 52 provided in the May 22, 2006, Office Action, the last substantive Action to issue in this case. Applicant addressed the rejection of claim 52 in a Reply filed October 24, 2006. As provided by MPEP 707.07(f), "where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." In the present case, Applicant's arguments regarding claim 52 have not been addressed as required by the MPEP. It is therefore respectfully requested that, if the rejection of claim 52 under 35 U.S.C. 102(b) is not withdrawn, that the examiner issue a further non-final Office Action in which Applicant's previous arguments regarding claim 52 are addressed. It is requested that any such Office Action be made non-final because Applicant should have had the benefit of the examiner's response to the previous arguments when responding to the present non-final Office Action.

It is also noted that the "Response to Arguments" section of the Office Action refers to

“claims 1-7” which is apparently a typographical error. It is respectfully requested that the specific claims being referenced be identified in the next Office Action so that Applicant can determine which arguments apply to which pending claims.

REJECTIONS UNDER 35 U.S.C. 102(b)

In Applicant’s Statement of the Substance of the Interview, filed on October 24, 2006, it is noted that the examiner is interpreting the portion of Shaw’s email application that connects to the internet as corresponding to the “application” recited in claim 52. As argued in that Reply, it does not appear that Shaw ever receives a request to run the communications portion of the email application using “additional data to be operated on by the application” before running the application or displaying an advertisement based on additional advertising data as required by claim 52. If this is not the interpretation of “application” being used in the Office Action, it is respectfully requested that the examiner make of record a statement explaining exactly what portion of Shaw’s email program is believed to correspond to the “application” recited in claim 52 so that the rejection can be better understood. Under the above interpretation, each limitation recited in claim 52 is not shown by Shaw, and claim 52 is submitted to be allowable over Shaw for at least this reason.

A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN PRESENTED

Claims 40-47, 49-51 and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Granik. These claims are addressed individually below. However, it is respectfully submitted that the modification to Shaw being proposed has not been identified and a proper reason for modifying Shaw has not been provided. For these reasons, a prima facie case of obviousness has not been presented in connection with claims 40-47, 49-51 and 53-55, and these claims are submitted to be allowable over the art of record.

Section 706.02(j) of the MPEP provides that, in order to support an obviousness rejection, an Office Action must set forth:

“the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,”

“the difference or differences in the claim over the applied reference(s),”

“the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter” and

“an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.”

The Office Action indicates that Shaw fails to teach “after the application is terminated, receiving and saving additional data to be operated upon by the application and additional advertising data,” but that Granik teaches a system that receives automatic updates. It is respectfully submitted that this statement in no manner explains what change to Shaw is being proposed. Giving Shaw the ability to download program updates would not make the above limitation obvious. If this rejection is maintained, it is respectfully requested that the examiner more clearly explain what modification to Shaw is being proposed so that Applicant can understand the basis for this rejection.

It is also respectfully submitted that modifying Shaw “because of all the reasons found in Granik” does not explain why one skilled in the art would have found it beneficial to modify Shaw in some manner. Shaw already has the ability to target advertisements based on user demographic information (column 12, lines 44-57) and one skilled in the art would have no need to modify Shaw based on Granik to obtain this functionality as suggested in the Office Action. No other reason for modifying Shaw has been provided. For this reason as well, a prima facie case of obviousness has not been presented.

In view of the above, it is respectfully submitted that the record does not show how the examiner is proposing to modify Shaw or provide a reason one skilled in the art would find it desirable to make a modification to Shaw. For these reasons, a prima facie case of obviousness has not been provided in connection with claims 40-47, 49-51 and 53-55 and these claims are submitted to be allowable for at least this reason.

REJECTIONS UNDER 35 U.S.C. 103(a)

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Granik. Claim 40 is directed to a method of presenting advertising information that includes a

step of storing an application. It is believed that the examiner is interpreting the portion of Shaw's email program that connects to the internet as corresponding to the claimed "application." Under this interpretation, it is not clear what information in Shaw comprises "data to be acted on by the application." The portion of Shaw's program that connects to the internet might store a telephone number or a password for establishing a connection. Therefore, it appears that when Shaw establishes a connection with the internet, he "runs the application." After the application is terminated, that is, apparently, after Shaw disconnects from the internet, Shaw would have to "receive and save additional data to be acted on by the application." Nothing in Shaw suggests that after Shaw disconnects from the internet Shaw receives any additional data, much less additional data that will be used by the portion of Shaw that connects to the internet. Since no information is received while Shaw is disconnected, no additional data exists to be used by the portion of Shaw that connects to the internet.

The Office Action cites to Granik to show the automatic downloading of program updates. However, under the above interpretation of "the application," Shaw is disconnected from the internet when such program updates need to occur. Nothing in Shaw or Granik suggests receiving additional data while disconnected from the internet. Therefore, even if a motivation for modifying Shaw were provided, the result would not be the invention of claim 40. Claim 40 is submitted to be allowable over the art of record for at least this reason.

Claims 41-46 depend from claim 40 and are submitted to be allowable for at least the same reasons as claim 40.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Granik. It appears that the examiner is interpreting the portion of Shaw's program that connects to the internet as corresponding to "the application" in claim 47 as well. However, nothing in Shaw or Granik suggests that additional information to be used by the portion of Shaw that connects to the internet is ever provided. The fact that Granik provides automatic program updates in no manner addresses this shortcoming. Moreover, claim 47 recites that the additional data is received when the processor is "not running the application." Neither Shaw nor Granik suggests receiving information when not connected to the internet as would seem to be required under the interpretation being used. For these reasons, and the reasons provided above in

connection with claim 40, claim 47 is submitted to be allowable.

Claims 48-51 depend from claim 47 and are submitted to be allowable for at least the same reasons as claim 47.

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Granik. Claim 53 is submitted to be allowable for at least the reasons provided above in connection with claim 47. In addition, claim 53 specifies that the data to be acted upon by the application does not comprise advertising information or formatting information for advertising information. The Office Action acknowledges that this limitation is not satisfied by Shaw. However, the present rejection of claim 53 continues to refer to the "additional information" as the advertising formatting information (the PDL notations are mentioned at page 9, last paragraph, of the Office Action). It is respectfully submitted that the calling the formatting information the additional information is inconsistent with the language of claim 53, and claim 53 is submitted to be allowable for at least this reason.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Granik. Claim 54 is submitted to be allowable for at least the reasons provided above in connection with claim 40. In addition, claim 54 specifies that "data to be acted upon by the application does not comprise advertising information or formatting information for advertising information." However, as discussed above in connection with the rejection of claim 53, the rejection of claim 54 continues to refer to the advertising formatting data as comprising the additional data. It is respectfully submitted that this interpretation is inconsistent with the language of claim 54 and that claim 54 is allowable for this reason as well.

Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Granik. Claim 55 is submitted to be allowable for at least the reasons provided above in connection with claim 52. In addition, claim 55 specifies that "data to be acted upon by the application does not comprise advertising information or formatting information for advertising information." However, as discussed above in connection with the rejection of claim 53, the rejection of claim 55 continues to refer to the advertising formatting data as comprising the additional data. It is respectfully submitted that this interpretation is inconsistent with the language of claim 55 and that claim 55 is allowable for this reason as well.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Granik and further in view of Acres. Claim 48 depends from claim 47. Acres does not address the shortcomings of Shaw and Granik discussed above in connection with claim 47. Claim 48 is therefore submitted to be allowable for at least the same reasons as claim 47.

In addition, the record does not show what modification to Shaw and Granik is being proposed to make turn Shaw into a game. Shaw is an email program. If this rejection is maintained, it is respectfully requested that the examiner explain what modification is being proposed to Shaw to turn Shaw into a game and provide a reason why one skilled in the art would find it desirable to turn Shaw's email program into a game. Stating that the references should be "combined" does not satisfy the requirements of MPEP 706.02(j). Claim 48 is submitted to be allowable over the art of record for this reason as well.

CONCLUSION

Each issue raised in the Office Action dated April 11, 2007, has been addressed, and it is believed that claims 40-55 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/003,069
Amendment dated June 25, 2007
Reply to Office Action of April 11, 2007

Docket No.: 0033-0778P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

Dated: June 25, 2007

Respectfully submitted,

By  37,750
Charles Gorenstein

Registration No.: 29,271

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant